BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

First Named Inventor	:	Jai RAWAT
Serial No.	:	09/846,741
Filed	:	May 1, 2001
Art Unit	:	2141
Confirmation No.	:	4472
Examiner	:	Kristie Shingles
Title	:	METHOD AND SYSTEM OF AUTOMATING DATA CAPTURE FROM ELECTRONIC CORRESPONDENCE
Attorney Docket No.	:	OBON0004

June 10, 2008

MAIL STOP: APPEAL BRIEF - PATENTS
Honorable Commissioner of Patents & Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Applicant's Appeal Brief follows.

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REAL PARTY IN INTEREST

The real party in interest is the assignee of the patent application, AOL LLC, having an address at 22000 AOL Way, Dulles, VA 20166-9323. AOL LLC's interest in the application is the subject of a recorded assignment which appears at Reel/Frame: 019711/0316.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

The status of the claims is as follows:

Claims 1-10 are rejected. Each of these claims is on appeal.

STATUS OF AMENDMENTS

Applicant's reply filed March 20, 2007 as a Preliminary Amendment was considered and entered, as stated at item I. in the Non-Final Office Action, dated June 28, 2007.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention is concerned with automating data capture from electronic correspondence, as set forth in independent Claims 1 and 6 as follows:

1.   A system for capturing electronic receipts from electronic mail messages (page 19, lines 18-20) comprising:

a first computer server (Figure 3: 399) configured for receiving a plurality of electronic mail messages (page 18, lines 15-18) and for parsing said electronic mail messages to identify a subset thereof which comprise commercial correspondence having commercial data related to a commercial transaction (page 19, lines 4-6);

wherein said plurality of electronic mail messages comprises electronic mail messages comprising commercial correspondence and electronic mail messages not comprising commercial correspondence (page 18, lines 3-5; page 19, lines 4-6); and

program code residing on said first computer server (page 18, lines 15-16) for creating receipt data by extracting said commercial data from said subset of electronic mail messages which comprise commercial correspondence (page 19, lines 18-20).

6.   A method of capturing electronic receipts from electronic mail messages (page 19, lines 18-20), the method comprising the steps of:

receiving a plurality of electronic mail messages by a first computer server (page 18, lines 15-18; Figure 3: 399), said plurality of electronic mail messages comprising electronic mail messages comprising commercial correspondence and electronic mail messages not comprising commercial correspondence (page 18, lines 3-5; page 19, lines 4-6);

parsing said electronic mail messages to identify a subset thereof which comprise commercial correspondence having commercial data related to a commercial transaction

(page 19, lines 4-6); and

creating receipt data by extracting said commercial data from said subset of electronic mail messages which comprise commercial correspondence (page 19, lines 18-20).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following ground for rejection is to be reviewed on appeal:

1.   Whether the subject matter of Claims 1-10 is anticipated by Sheldon *et al* (USPN 6,708,205) under 35 USC §102(e).

ARGUMENTS

Claims 1-10 are rejected under 35 U.S.C. §102(e) for being anticipated by U.S. Pat. No. 6,708,205 to Sheldon *et al* (hereinafter, "Sheldon").

The application at issue was filed May 1, 2001. Sheldon was filed February 14, 2002 and claims priority to U.S. Serial No. 60/269,284 (hereinafter, "the provisional"), which was filed February 15, 2001. The Examiner relies upon the provisional application to support Sheldon's critical reference date. (Final Action: pages 2-3) However, if the provisional application does not disclose the subject matter of the rejected claims, Sheldon cannot anticipate them. Because Sheldon was filed after the application at issue, Sheldon cannot be considered prior art to the extent that its contents are not supported by the provisional application. (35 USC §102(e))

The Provisional Application Does Not Support the Disclosure in Sheldon Relied upon by the Examiner As a Basis for Finding Anticipation

The 35 U.S.C. §102(e) critical reference date of a U.S. patent is entitled to the benefit of the filing date of a provisional application under 35 U.S.C. §119(e) *if* the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. §112, first paragraph. (MPEP 2136.03 III) Thus, the specification must contain a written description in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the invention. (35 U.S.C. §112) The provisional application does not support the disclosure in Sheldon relied upon by the Examiner to support anticipation of Claim 1.

The First Element of Claim 1 Is Not Supported by the Provisional Application

The Examiner asserts that Sheldon teaches the first element of Claim 1, which recites: "a first computer server configured for receiving a plurality of electronic mail messages and for parsing said electronic mail messages to identify a subset thereof which comprise commercial correspondence having commercial data related to a commercial transaction" at column 19, lines 42-62; column 20, lines 21-26; and column 21, line 66-column 22, line 50 of Sheldon.

Sheldon describes a system for parsing emails and sending them to different directories. (Column 19, lines 42-45) The system organizes emails according to categories specified by a user by parsing out the suffix contained in each email. (Column 21, lines 1-56) The system can create directories for emails containing a commercial suffix. (Column 21, line 66-column 22, line 15) The directories can allow customers to engage in e-commerce. (Column 22, lines 13-14) For example, the system can use an extractor to parse travel information from emails having a travel@company.com suffix. (Column 24, lines 22-41)

The provisional application discloses a system where the user creates multiple email addresses and the system creates folders organized according to the suffix contained in each email address. (Page 133) Claim 14 recites a system having a database with locations for storing electronic messages sent by third parties with commercial names. (Page 176) However, the provisional application does not disclose how the system

distinguishes between commercial suffixes and non-commercial suffixes. Furthermore, there is no indication that the system recognizes emails related to a commercial transaction, as described in Sheldon. Thus, the provisional application does not support the disclosure in Sheldon that the Examiner cites as anticipating the first element of Claim 1.

The Third Element of Claim 1 Is Not Supported by the Provisional Application

The Examiner asserts that Sheldon teaches the third element of Claim 1, which recites: "program code residing on said first computer server for creating receipt data by extracting said commercial data from said subset of electronic mail messages which comprise commercial correspondence" at column 24, lines 10-41 and column 25, lines 16-25.

Sheldon discloses a system that can extract information from emails. (Column 24, lines 12-14) For example, the system can create a report of travel expenses extracted from emails that have the subject line: "CONFIRMATION: miscellaneous text." (Column 24, lines 22-27)

The provisional application, on the other hand, makes no mention of creating a report or extracting information from emails to create a receipt. The Examiner cites pages 25-28 of the provisional application to support the assertion that the provisional application adequately supports Sheldon. Applicant respectfully disagrees.

The provisional application recites charging an account corresponding to an electronic message address, creating a receipt for the account charge, formatting the receipt, and sending the receipt to the sender. (Page 25, paragraph 1) The receipt is not created by extracting data from emails; the receipt is created in response to charging an account.

The provisional application recites receiving a receipt for a request corresponding to an electronic message address from a third party and formatting the receipt into an electronic message. (Page 25, paragraph 2) This is not the same as extracting information. Extraction indicates a process where certain pieces of information are removed. Thus, extraction results in fewer pieces of information. Formatting is a process of changing the appearance of the information. Here, all the information from the receipt is converted into an email. Thus, this paragraph does not describe extracting information from an email. In addition, even if formatting was the same as extracting, this paragraph only discusses altering a *single* receipt. Sheldon, on the other hand, discusses creating a report from multiple emails.

The Examiner also cited pages 26-28 for support, however, these pages discuss variants of the embodiments on page 25 that also describe formatting a single receipt. In addition, contrary to the Examiner's assertion that Applicants performed a cursory review of the provisional application, Applicants have carefully examined the provisional application and find no mention of the term "extract" or any other process of searching through emails to obtain a subset of information. Thus, the provisional application does not support the

disclosure in Sheldon that the Examiner cites as anticipating the third element of Claim 1.

Conclusion

The Examiner acknowledges that Sheldon is defective under 35 USC §102(e) because Sheldon was filed after the application at issue. The Examiner relies upon the provisional application to correct this defect. The provisional application, however, does not teach how the system distinguishes between commercial suffixes and non-commercial suffixes, there is no indication that the system recognizes emails related to a commercial transaction, and the provisional application does not teach creating a report or extracting information from emails to create a receipt. Thus, Sheldon is not prior art.

Claims 2-5

Because Claims 2-5 depend upon Claim 1, they are patentable for at least the same reasons as Claim 1.

Claim 6

Claim 6 is also rejected under 35 USC 102(e) in view of Sheldon. Because Sheldon is not prior art for the reasons mentioned above, Claim 6 is patentable.

Claims 7-10

Because Claims 7-10 depend upon Claim 6, they are patentable for at least the same reasons as Claim 6.

CONCLUSION

For the foregoing reasons, Sheldon is not entitled to the priority date of the provisional application and, therefore, is not prior art. On June 28, 2007, the Examiner indicated that the allowable subject matter of Claims 1 and 6 was withdrawn in view of Sheldon. Because Sheldon is not prior art, Applicants believe that the Examiner should be reversed and ordered to pass the case to issue.

The Commissioner is authorized to charge any fees due, to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862 (Attorney Docket No. OBON0004).

Respectfully submitted,

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CLAIMS APPENDIX

1.   A system for capturing electronic receipts from electronic mail messages comprising:

a first computer server configured for receiving a plurality of electronic mail messages and for parsing said electronic mail messages to identify a subset thereof which comprise commercial correspondence having commercial data related to a commercial transaction;

wherein said plurality of electronic mail messages comprises electronic mail messages comprising commercial correspondence and electronic mail messages not comprising commercial correspondence; and

program code residing on said first computer server for creating receipt data by extracting said commercial data from said subset of electronic mail messages which comprise commercial correspondence.

2.   The system of Claim 1, wherein said first computer server permits display of receipt data.

3.   The system of Claim 1, further comprising:

a database at said first computer server,

wherein said first computer server permits alteration of header data of said electronic mail messages in accordance with data records stored in said database.

4.   The system of Claim 3, wherein said program code comprises:

instructions for storing said receipt data in said database.

5.   The system of Claim 4, wherein said first computer server permits extraction of said receipt data from said database.

6.   A method of capturing electronic receipts from electronic mail messages, the method comprising the steps of:

receiving a plurality of electronic mail messages by a first computer server, said plurality of electronic mail messages comprising electronic mail messages comprising commercial correspondence and electronic mail messages not comprising commercial correspondence;

parsing said electronic mail messages to identify a subset thereof which comprise commercial correspondence having commercial data related to a commercial transaction; and

creating receipt data by extracting said commercial data from said subset of electronic mail messages which comprise commercial correspondence.

7.   The method of Claim 6, further comprising the step of:

updating header data of said subset of electronic mail messages.

8.   The method of Claim 7, wherein said step of updating header data further comprises the steps of:

querying a database of address data; and

altering header data of said subset of electronic mail messages in accordance with a result of said step of querying.

9.   The method of Claim 6, wherein said step of extracting further comprises the steps of:

querying a database of template data; and

comparing each of said subset of electronic mail messages with said template data obtained from said step of querying.

10.   The method of Claim 6, further comprising the steps of:

providing a database for storing receipt data; and

storing identified commercial data as receipt data in said database.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.